

PATENT

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(signature)
Date of signature and deposit - January 12, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
FORREST P. GAUTHIER

Serial No. 10/707,955

Filed: January 28, 2004

For: METHOD OF UTILIZING
VARIABLE DATA FIELDS
WITH A PAGE DESCRIPTION
LANGUAGE

) Group Art Unit 2625
)
)
) Examiner Gabriel I. Garcia
)
)
) Confirmation No. 1954
)
) Attorney Docket 1-27276

Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

INFORMATION DISCLOSURE STATEMENT

Honorable Sir:

Pursuant to 37 C.F.R. 1.97(c), record is hereby made of information that the Patent Office may wish to consider in connection with its examination of the above-identified application. A completed PTO-1449 form is enclosed, together with copies of the foreign patent documents and non-patent literature (if any) cited therein. Please charge Deposit Account No. 13-0005 in the amount of \$180.00 to cover the fee pursuant to 37 C.F.R. 1.17(p). A duplicate copy of this sheet is enclosed.

United States Patent Nos. 5,729,665, 5,937,153, 6,209,010, 6,381,028, 6,487,568, 6,599,325, 6,687,016, and 6,771,387 have been the subject of prior litigation. The present application is a continuation of U.S. Patent Application Serial No. 10/090,074, now U.S. Patent No. 6,771,387, which was a continuation of U.S. Patent Application Serial No. 09/299,502, now U.S. Patent No. 6,381,028, which was a continuation of U.S. Patent Application Serial No. 08/896,899, now U.S. Patent No.

Applicant believed at the time and continues to believe that the allegations are completely without merit and have no bearing on the patentability of the present pending application. However, to insure that Applicant is fully meeting his duty of candor, Applicant is disclosing the following information.

Scitex alleged that the '665 patent was invalid under 35 U.S.C. § 102 as being invalid based upon public use and/or on sale activity by Applicant, without any further specification. Scitex also alleged that the '665 patent was invalid under 35 U.S.C. § 102, 103 as being invalid based upon Scitex's "DijiComp" products and Monarch Marking Systems, Inc.'s label printing products that were publicly known before January 18, 1994. Scitex further alleged that the '665 patent was invalid under 35 U.S.C. § 102 as being invalid based upon anticipation or obviousness, without any further specification. No information pertaining to the validity of the '665 patent was made available to Applicant.

Scitex alleged that the '665 patent was invalid under 35 U.S.C. § 112 as being invalid based upon failing to meet the requirements of 35 U.S.C. § 112, paragraphs 1 and/or 2.

On February 13, 2002, the Court dismissed the complaint with prejudice for failure to prosecute its claims against Scitex Digital Printing, Inc. The Court also refused to grant Scitex's default-judgment motion to declare the '665 patent invalid because Scitex did not present any evidence to the court supporting such allegations.

It is to be understood that the present disclosure of art is in no way intended to be a waiver of any arguments or defenses available to the Applicant under the rules of the U.S. Patent and Trademark Office and the statutes of the United States.

Respectfully submitted,



Staci E. Schweikert
Reg. No. 52,200

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900

5,937,153, which was a continuation-in-part of U.S. Patent Application Serial No. 08/373,582, now U.S. Patent No. 5,729,665. A summary of this litigation and the allegations made during such litigation follows.

Notice of Prior Litigation Allegations

Suit 1 - Tesseron, Ltd. v. Xerox Corporation

Pursuant to a patent infringement suit (Case No. 1:04CV2164) filed on October 28, 2004 by Tesseron, Ltd. against Xerox Corporation (Xerox), Applicant became aware of allegations of invalidity regarding United States Patent Nos. 5,937,153, 6,209,010, 6,381,028, 6,487,568, 6,599,325, 6,687,016, and 6,771,387. Applicant believed at the time and continues to believe that the allegations are completely without merit and have no bearing on the patentability of the present pending application. However, to insure that Applicant is fully meeting his duty of candor, Applicant is disclosing the following information.

Xerox asserted that various claims in U.S. Patent No. 6,687,016 and U.S. Patent No. 6,771,387 were invalid under 35 U.S.C. § 102 and/or § 103 in view of European Patent Specification EP0394168 B1, European Patent Application EP 0539135 A2, and Japanese Patent Application Publication JP 63-108428 A and/or U.S. Patent No. 5,465,165 to Tanio. Each of these references has been listed on a previously submitted Information Disclosure Statement.

Xerox asserted that Xerox conceived, reduced to practice and sold XGF software before the critical date of U.S. Patent Nos. 6,209,010, 6,487,568, and 6,599,325. With respect to these patents, Xerox asserted that Xerox is practicing its XGF prior art, such as shown in the Xerox Generic Format ("XGF") Reference Manual Version 1.4, June 1995, and/or prior public uses of XGF or VIPP in the United States. Xerox alleged that to the extent that Tesseron asserted that the accused product infringed any claims of these patents, these claims were anticipated under 35 U.S.C. § 102 and/or § 103.

Xerox further asserted that Jean-Yves Bouche and Carlo Sans of Xerox were designing and developing its XGF software in Switzerland at least as early as 1992 in

response to a customer request for certain printing-related functionality. Xerox asserted that Xerox had also designed, marketed, and sold its XGF software at least as early as 1992 and that Xerox had designed, developed, and/or sold its Interpress software having variable image capability at least as early as 1981.

Xerox also asserted that older versions of Xerox's VIPP software were prior art against some of these patents. Xerox asserted that Tesson's first word-wrapping patent was filed in 1997 (referencing an application that matured into U.S. Patent No. 6,209,010) after Xerox's variable data printing products were on the market. Xerox further asserted that to the extent that one or more claims of U.S. Patent Nos. 6,209,010, 6,487,568, and 6,599,325 were broad enough to encompass VIPP, then those claims were invalid because VIPP utilized and disclosed a command called SHP (which included the SETCOLWIDTH command) to perform text-wrapping more than one year prior to the filing date of the applications for those patents.

Xerox asserted that variable printing was done long before Mr. Gauthier's work, including as far back as the 1970s. Xerox asserted that Xerox's 9700 and IBM's 3800-3 were examples of intelligent printers in the 1970s that handled variable data jobs using page description languages, and cited the following documents:

1. McGraw-Hill, Inc., Business Week: Information Processing: Data Processing. Industrial Edition June 9, 1980. (submitted with an earlier-filed Information Disclosure Statement).
2. McGraw-Hill, Inc., Business Week: Product Design. Industrial Edition. June 20, 1977. (submitted with an earlier-filed Information Disclosure Statement).
3. Xerox Variable Printing PowerPoint Presentation (included herewith).

Xerox further asserted that page description languages had been used at least as early as 1977 to describe variable documents, including Xerox's 9700 intelligent printer, commercialized in 1977, and utilized a proprietary page description language to describe variable documents. Xerox asserted that PostScript Level 2 available in 1990 was a page description language that was (and is) often used to describe variable documents, and cited the following documents:

1. U.S. Patent No. 5,937,153 Col. 2, lines 53-55, Col. 4, lines 20-24 and 33-42 (submitted with an earlier-filed Information Disclosure Statement).

2. PostScript Language Reference Manual, Second Edition 1990, pages 172-173 (submitted with an earlier-filed Information Disclosure Statement).

Xerox further asserted that PostScript device-independent page description language was introduced in 1985, and Postscript Level 2 allowed variable printing of forms using PostScript alone and was commercialized in 1990, long before the filing dates of these patents, and cited the following documents:

1. PostScript Language Reference Manual, Second Edition 1990, pages 172-173 (submitted with an earlier-filed Information Disclosure Statement).
2. Understanding PostScript, Third Edition 1992, pages 268-269, and Postscript By Example, 1993, pages 463-470, (submitted with an earlier-filed Information Disclosure Statement).

Xerox characterized the state of the art as shown in the Xerox Corporation's Technical Tutorial dated September 19, 2005, which is included herewith. Xerox specifically asserted that the prior art worked as shown at page 50 of the Xerox Corporation's Technical Tutorial dated September 19, 2005.

Xerox further listed the following items as "Public Uses and/or Offers for Sale:" Xerox Corp. FormMerge and Xmerge utilities; Xerox Corp. Interpress PDL; Xerox Corp. Xerox 9700 Printing System; Xerox Corp. Xerox Generic Format ("XGF") (all versions predating the patents-in-suit); and Xerox Corp. DocuTech. Various reference manuals for the Xerox 9700 Printing System and for Xerox Generic Format are being submitted on Information Disclosure Statements filed contemporaneous to this Information Disclosure Statement.

Xerox also alleged that Applicant, Forrest Gauthier, committed inequitable conduct during the prosecution of the patent applications that matured into these patents on at least the grounds that, during prosecution of each of these applications, Mr. Gauthier was aware of, yet failed to submit to the U.S. Patent and Trademark Office, two material prior art references, U.S. Patent No. 5,465,165 to Tanio and U.S. Patent No. 5,740,338 to Gauthier. Both of these references have been listed on an earlier-filed Information Disclosure Statement.

Tesseron, Ltd. and Xerox Corporation reached a settlement agreement and all complaints were dismissed from the United States District Court of the Northern

District of Ohio on July 5, 2006.

Suit 2 - Tesseron, Ltd. v. GMC Software AG and GMC Software Technology, Inc.

Pursuant to a patent infringement suit (Case No. 1:04CV2182) filed on November 1, 2004, by Tesseron, Ltd. against GMC Software AG and GMC Software Technology, Inc. (GMC), Applicant became aware of allegations of invalidity regarding United States Patent Nos. 5,937,153, 6,209,010, 6,381,028, 6,487,568, 6,599,325, 6,687,016, and 6,771,387. Applicant believed at the time and continues to believe that the allegations are completely without merit and have no bearing on the patentability of the present pending application. However, to insure that Applicant is fully meeting his duty of candor, Applicant is disclosing the following information.

GMC asserted that these patents were invalid because the accused versions of the PrintNet software were in public use or on sale in the United States and/or were described in a printed publication anywhere in the world prior to January 18, 1994. GMC also asserted that these patents were invalid in view of several prior art patents relating to bitmap printing including, but not limited to, U.S. Patent Nos. 5,465,165 to Tanio, 5,740,338 to Gauthier, 4,857,955 to Crandall, and 5,157,765 to Birk. GMC also asserted that these patents were invalid in view of several prior art patents relating to text wrapping, including U.S. Patent Nos. 5,946,461 to Laudry, 5,729,665 to Gauthier, 5,465,165 to Tanio, 5,740,338 to Gauthier, 4,857,955 to Crandall, and 5,157,765 to Birk. Each of these patents was listed on an earlier-filed Information Disclosure Statement.

Tesseron, Ltd. and GMC reached a settlement agreement and all complaints were dismissed from the United States District Court of the Northern District of Ohio on July 5, 2006, prior to any ruling on the Markman Hearing.

Suit 3 - Varis Corporation v. Scitex Digital Printing, Inc.

Pursuant to a patent infringement suit (Civil No. C-1-99-336) filed on May 25, 1999, by Varis Corporation against Scitex Digital Printing, Inc., Applicant became aware of allegations of invalidity of United States Patent No. 5,729,665 (hereinafter the '665 patent).

